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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,922	08/27/2001	Stanley P. Dabrowski	G&C 31003.1USU5	5353

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EXAMINER

LE, UYEN CHAU N

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/939,922

Applicant(s)

DABROWSKI, STANLEY P.

Examiner

Uyen-Chau N. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to because of minor informality, that is, with respect to **Fig. 1**, **please label all the pertinent components/parts/steps**, such as, gaming device and its banks, data manager, intranet server, work stations, communication link, etc. for examining purposes. Appropriate correction is required.

### *Provisional Obviousness-Type Double Patenting*

2. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/366,224 (hereinafter '224).

Although the conflicting claims are not identical, they are not patentably distinct from each other because in claim 1 of the instant application, Applicants claim a method of providing at least one **scrip** from a gaming device, comprising the steps of **"accepting a cash-out command in the gaming device"**, **"scanning a magnetically manifested code uniquely identifying a scrip stored in the gaming device"**, **"transmitting a cash-out message comprising the code to a remote processor having access to a database for storing and retrieving codes from a plurality of gaming devices"**, **"receiving a scrip dispense message from the remote processor"**, and **"dispensing the scrip"**. The '224 application discloses a method of providing at least one **scrip** from a gaming device, comprising the steps of **"accepting a cash-out command at the gaming device"**, **"scanning a code on the pre-coded scrip in response to the**

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cash-out command, wherein the code **uniquely identifies** the scrip”, “**transmitting the code to a remote processor having access to a database for storing and retrieving codes from a plurality of gaming devices**”, “**receiving a scrip dispense message from the remote processor**”, and “**dispensing the scrip**”. Although the scope of claim 1 of the present application and claim 1 of ‘224 application are almost identical, the difference between the present claimed invention and the ‘224 application is that the present claimed invention is a broader recitation of the ‘224 application (e.g., the present claimed invention recites “**scanning a magnetically manifested code uniquely identifying a scrip** stored in the gaming device, etc.” whereby the ‘224 application recites “**scanning a code on the pre-coded scrip** in response to the cash-out command, wherein the code **uniquely identifies** the scrip, etc.”). Thus, with respect to above discussions, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use the teaching of claim 1 of ‘224 application as a general teaching for having a method of providing at least one **scrip** from a gaming device with the same steps/functions as claimed by the present application. The instant claims obviously encompass the patented claims and differ only in terminology. To the extent that the instant claim is broaden and therefore generic to the patented claims [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been patented.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3 and 6-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burns (WO 94/16781 – cited by the applicant) in view of Black et al (US 4,835,624).

Re claims 1-3 and 7-17, Burns shows and discloses a method and device of providing at least one scrip from a gaming device comprising the steps of accepting a cash-out command at a gaming device from a remote processor/from a user playing the gaming device; scanning via scanning means 206 a code uniquely identifying a scrip 222; transmitting a cash-out message comprising the code to a remote processor 100 having access to a database for storing and retrieving codes from a plurality of gaming devices; receiving a scrip dispense message from the remote processor 100; and means for dispensing the scrip 222, wherein the cash-out message further comprises a cash-out balance (Fig. 1; abstract; p.4, lines 6-15; and p. 8, line 25 – p. 11, line 17).

Burns further discloses a magnetic code reader for reading a magnetic stripe 662 on the player card 660, but fails to teach or fairly suggest the scrip having a magnetically manifested code. Burns also fails to teach or fairly suggest the use of a scrip transducer for reading and recording a magnetic manifested code on a scrip.

Black et al teaches each lottery ticket 64 having a magnetic code 84, which can be read and recorded by a magnetic read head 54 and a magnetic write head 32, which serves as a transducer (figs. 4 and 5; col. 5, lines 5-39).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of into the teachings of Burns in order to provide Burns with a more secure system wherein the magnetic code can only be recognized/read by a machine/magnetic reader (i.e., a transducer or magnetic read/write head, etc.). Furthermore, such modification would have been merely a substitution of equivalents well within the ordinary skill in the art, and therefore an obvious expedient.

Re claim 6, Burns as modified by Black et al has been discussed above, but fails to teach or fairly suggest that the code uniquely identifying the scrip is pre-coded.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate a pre-coded code into the teachings of Burns/Black et al in order to provide Burns/Black et al with a more feasible system wherein the printer is not required in the gaming device, and thus providing a more compact system due to the space saving of the unused printer. Furthermore, such modification would provide Burns/Black et al with a faster system wherein the scrip can be dispensed readily without waiting for the printer/magnetic write head to print/write, and thus providing a more user-friendly system.

5. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burns as modified by Black et al as applied to claim 1 above, and further in view of Walker (WO 95/24689). The teachings of Burns as modified by Black et al have been discussed above.

Re claims 4 and 5: Burns/Black et al have been discussed above but fail to teach or fairly suggest that the transmitted data is encrypted.

Walker teaches the data transmitting between the player and the wagering establishment is encrypted (figs. 1A through 2; abstract; and page 18, lines 2+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Walker into the teachings of Burns/Black et al in order to provide Burns/Black et al with a more secure system preventing the transmitted data from being read and/or manipulated by an unauthorized operator. Furthermore, such modification would have been an obvious extension as taught by Burns/Black et al, and therefore, an obvious expedient.

### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Walker et al (US 6,527,638); Schneier et al (US 5,871,398); Walker et al (US 6,024,640); Behm et al (US 5,475,205); Sultan (US 6,270,406); Walker et al (US 6,190,256); Burns (US 6,048,269); Alexoff et al (US 4,858,123); Saunders et al (US 6,012,832); Troy et al (US 4,689,742); Cohen et al (US 5,231,568); Haste III (US 5,595,538); Saunders (WO 98/59311); and Bischofsberger (DE 3406058) are cited as of interest and illustrate a similar structure to a method and apparatus for scrip distribution and management permitting redistribution of issued scrip.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588. The examiner can normally be reached on SUN, M,W, F 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

*Uyen -Chau Ngo Le*

April 20, 2003



KARL D. FRECH  
PRIMARY EXAMINER